

**In the Drawings:**

The attached sheets of drawings include changes to FIG. 3. These sheets replace the original sheets.

## **REMARKS**

This is a full and timely response to the outstanding non-final Office Action mailed December 3, 2004. Upon entry of the amendments in this response, claims 1 - 16 remain pending. In particular, Applicant has amended claim 1 and has added claim 16. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

### **Response to Arguments**

The Office Action indicates that Applicant's preamble has not been afforded patentable weight because "...the body of the claim does not depend on the preamble for completeness. . .". Applicant respectfully notes, however, that several of the pending claims recite language from the preamble of the claim in their respective bodies. By way of example, claim 1 recites "a surface passivation layer for *said ESD protection device*;" claims 6 and 7 recite "*NFET elements*;" and claims 13 and 14 recite "*said active semiconductor devices*," each of which occurs in the body of the claim indicated. Conventionally, patentable weight has been afforded preamble language in such circumstances. Therefore, Applicant respectfully requests reconsideration of the pending claims for at least this reason.

### **In the Drawings**

The Office Action indicates that the drawings are objected to under 37 CFR 1.84(p)(5) because they include reference characters not mentioned in the specification. In this regard, Applicant submits herewith replacement sheets of drawings that include changes to FIG. 3, as

requested by the Office Action. Specifically, the mentioned reference characters have been removed. No new matter has been added.

### **Rejections under 35 U.S.C. 103**

The Office Action indicates that claims 1, 3-7, 9, 12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Prior Art in view of *Jun* (US Publication No. 2002/0084485) and *Floyd* (US Publication No. 2002/0055232). The Office Action also indicates that claim 2 is rejected over Applicant's Prior Art in view of *Jun*, *Floyd* and *Sheu* (US Patent No. 5,998,832); that claim 8 is rejected over Applicant's Prior Art in view of *Jun*, *Floyd* and *Liau* (US Patent No. 5,783,850); that claim 10 is rejected over Applicant's Prior Art in view of *Jun*, *Floyd* and *Chang* (US Patent No. 5,814,547); that claim 11 is rejected over Applicant's Prior Art in view of *Jun*, *Floyd* and *Hau* (US Patent No. 6,475,875); and that claims 13 and 14 are rejected over Applicant's Prior Art in view of *Jun*, *Floyd* and *Wolf Silicon Processing*. Applicant respectfully traverses the rejections.

In this regard, Applicant has amended claim 1 to recite:

**1. *A low capacitance depletion mode SCR and NFET element integrated circuit semiconductor device structure with associated parasitic bipolar transistors on a substrate for the purpose of providing electrostatic voltage discharge protection to the active semiconductor devices, comprising:***

- a first doped region of opposite dopant than said substrate;
- a second doped region, of opposite dopant than said first doped region, within said first doped region;
- a plurality of third doped regions within said substrate of opposite dopant than said substrate;
- a gate element overlaying said substrate surface between a first element and second element of said third doped regions;
- a gate element overlaying said substrate surface between a third element and fourth element of said third doped regions;

***a first isolation element, in contact with said first doped region, between said second element of said third doped region and a first side of said second doped region;***

***a second isolation element, in contact with said first doped region, between said third element of said third doped region and a second side of said second doped region;***

a plurality of fourth doped regions within said substrate of similar dopant as said substrate;

an electrical conductor system for said second doped region;

an electrical conductor system for said first and fourth elements of said third doped regions and for the first and second elements of said fourth doped regions;  
and

a surface passivation layer ***for said ESD protection device.***

*(Emphasis Added).*

Applicant respectfully asserts that the cited references are deficient for the purpose of rendering claim 1 unpatentable. In particular, the cited references, either individually or in combination, do not teach or reasonably suggest at least the features/limitations emphasized above in claim 1. Therefore, Applicant respectfully requests that claim 1 be placed in condition for allowance.

Since claims 3-7, 9, 12 and 15 are dependent claims that incorporate the limitations of claim 1, and are not otherwise rejected, Applicant respectfully asserts that these claims also are in condition for allowance. Additionally, these claims recite other features and combinations thereof that can serve as an independent basis for patentability.

Notably, however, the Office Action contends that claims 3 – 7 and 12 are unpatentable because Applicant somehow failed to show the critical nature of the recited limitations. In this regard, the Office Action relies on *In re Woodruff* for support. Although Applicant believes that the Office Action has correctly quoted a portion of this case, the legal implications of that portion have been taken out of context. In particular, although *In re Woodruff* does state that “the applicant must show that the particular range is critical, generally by showing that the claimed

range achieves unexpected results relative to the prior art range,” the Office Action has provided no prior art teach against which such criticality is to be shown.

In order to establish a prima facie case of obviousness, the Office Action must first provide a teaching, only then do the implications of *In re Woodruff* apply. That is,

When the difference between the claimed invention and the prior art is the range or value of a particular variable, then a prima facie rejection is properly established when the difference between the range or value is minor.  
(*In re Woodruff*, 919 F.2d 1575, 1578 (Fed. Cir. 1985)).

At this point, Applicant is unable to assess the difference between the prior art and the claimed ranges. Moreover, Applicant is not required to assert criticality in the disclosure, as such criticality or attainment of unexpected results can be provided through evidence submitted during prosecution. Therefore, Applicant respectfully asserts that the supplemental rejection of claims 3 – 7 and 12 are improper and respectfully requests that the rejections for lack of stated criticality be removed.

With respect to the rejections of the remaining claims, Applicant respectfully asserts that the asserted secondary references do not teach or reasonably suggest the features/limitations emphasized above as lacking in the rejection of independent claim 1. Since these claims incorporate the features/limitations of claim 1, Applicant respectfully asserts that these claims also are in condition for allowance.

#### **Newly Added Claim**

Upon entry of the amendments in this response, Applicant has added new claim 16. Applicant respectfully asserts that claim 16 is in condition for allowance for at least the reason that this claim is a dependent claim that incorporates the limitations of claim 1, the allowability

of which is described above. Further, the cited art, either individually or in combination, does not teach or reasonably suggest the additional structural limitation recited in claim 16. Therefore, Applicant respectfully requests that claim 16 be placed in condition for allowance.

**Cited Art of Record**

The cited art of record has been considered, but is not believed to affect the patentability of the presently pending claims.

## CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

No fee is believed to be due in connection with this Amendment and Response. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,

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